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4 UNITED STATES DISTRICT COURT
5 WESTERN DISTRICT OF WASHINGTON
6 AT SEATTLE

7 IRONBURG INVENTIONS LTD.,

8 Plaintiff,

9 v.

10 VALVE CORPORATION,

11 Defendant.

C17-1182 TSZ

MINUTE ORDER

12 The following Minute Order is made by direction of the Court, the Honorable
13 Thomas S. Zilly, United States District Judge:

14 (1) Defendant's motion for summary judgment,¹ docket no. 255, is DENIED in
15 part and GRANTED in part for the following reasons:

16 (a) In arguing that any infringement of U.S. Patent Nos. 8,641,525 (the
17 "'525 Patent'") and/or 9,089,770 (the "'770 Patent'") was not willful, defendant has
18 not carried its burden of demonstrating an absence of genuine disputes of material
19 fact, and its motion for summary judgment on the subject is denied. See Fed. R.
20 Civ. P. 56(a).

21 (b) In arguing that the accused device does not literally infringe the
22 '525 Patent or the '770 Patent because it does not have the requisite "elongate
23 member," defendant has not carried its burden of demonstrating an absence of
genuine disputes of material fact, and its motion for summary judgment on the

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21 ¹ Plaintiff's motion, docket no. 283, to strike Exhibits 7, 17, 18, 19, 20, and 26 to the declaration of
22 defendant's counsel Mark Schafer, docket no. 256, is DENIED. The Court is satisfied that the substance
23 of the exhibits at issue could be presented in an admissible form at trial and may therefore be considered
for purposes of dispositive motion practice. See Fed. R. Civ. P. 56(c). Plaintiff's attorneys are reminded
that requests to strike material filed by an opponent may not be presented in a separate motion or
"objection," but must instead be included within a response or reply brief. See Local Civil Rule 7(g).

1 subject is denied. In contending that the components alleged to be “elongate”
2 members are “less than 15% different from a perfect square” and therefore are not
3 of a form “notably long in comparison to its width,” defendant tries to constrain
4 the term “elongate member” to a definition that the Court did not adopt. See Order
5 at 12 (docket no. 189) (“The term ‘elongate member’ means what it says, and the
6 Court is satisfied that no further interpretation is necessary.”).

7 (c) In arguing that the accused device does not literally infringe the
8 ’525 Patent because the components alleged to be “elongate” members do not
9 extend “substantially the full distance between the top edge and the bottom edge”
10 of the controller, defendant has not carried its burden of demonstrating an absence
11 of genuine disputes of material fact, and its motion for summary judgment on the
12 subject is denied. In asserting that the alleged “elongate” members extend only
13 53% of the distance from the top edge to the bottom edge of the outer case of the
14 controller and therefore do not extend “largely but not necessarily the entire
15 distance between the top and the bottom edges,” see Order at 8-9 (docket no. 189),
16 defendant merely identifies a factual question as to whether 53% is “largely but
17 not necessarily the entire distance” at issue.

18 (d) In arguing that the accused device does not literally infringe
19 Claim 12 of the ’525 Patent because the alleged “elongate” members are not
20 “parallel to one another,” defendant fails to show that it is entitled to judgment as a
21 matter of law, and its motion for summary judgment on the subject is denied. See
22 Fed. R. Civ. P. 56(a). The fact that plaintiff’s expert has offered seemingly
23 contradictory opinions that the alleged “elongate” members are “parallel,” as
required in Claim 12 of the ’525 Patent, or “converge,” within the meaning of
Claim 13 of the ’525 Patent, does not support defendant’s motion. Plaintiff
is entitled to advance at trial alternative and inconsistent claims. See Fed. R. Civ.
P. 8(d)(2)&(3).

(e) In arguing that the accused device does not literally infringe
Claim 18 of the ’525 Patent because “at least one of the back controls” is not
“formed as an integral part of the outer case,” defendant has not carried its burden
of demonstrating an absence of genuine disputes of material fact, and its motion
for summary judgment on the subject is denied. Whether the “battery door” and
the accused “back controls” thereon constitute “an integral part of the outer case”
of the controller is a question for the trier of fact.

(f) In light of the above rulings, the Court does not rule on whether the
claim limitations “elongate member,” “substantially the full distance between the
top edge and the bottom edge,” “parallel to one another,” and/or “formed as an
integral part of the outer case” read on the accused device under the doctrine of
equivalents.

1 (g) With regard to defendant's argument that the accused device does
2 not literally or under the doctrine of equivalents infringe Claims 13 or 14 of the
3 '770 Patent, the motion for summary judgment is GRANTED. Claim 14 depends
4 from Claim 13, which depends from Claim 12, which depends from Claim 1. See
5 '770 Patent at Cols. 4-6, Ex. B to 2d Am. Compl. (docket no. 44-2). In Claim 1,
6 what is claimed is a "video game controller" comprised of "an outer case" with "a
7 front and a back, wherein the back is opposite the front." Id. at Col. 4, Lines 39-
8 41. Claim 13 requires that "the first switch mechanism" be "disposed between the
9 first elongate member and an outside surface of the back," and that "the second
10 switch mechanism" be "disposed between the second elongate member and the
11 outside surface of the back." Id. at Col. 6, Lines 1-5. Plaintiff appears to concede
12 that the requisite switch mechanisms on the accused device are not "disposed
13 between" the alleged elongate members and the outside surface of the back of the
14 outer case of the controller, but argues that the term "outside surface of the back,"
15 as set forth in Claim 13 (and incorporated into Claim 14), does not mean "outside
16 surface of the back of the outer case of the controller." Plaintiff's assertion, which
17 completely ignores the language of Claim 1, lacks merit. The term "back" is
18 defined in Claim 1 as one of the components of the outer case of the controller,
19 and thus, for purposes of Claims 13 and 14, the phrase "outside surface of the
20 back" means "outside surface of the back of the outer case of the controller."

21 (2) Defendant's motion to sever or stay, docket no. 292, is GRANTED as
22 follows. This case is hereby STAYED pending further order. Having reviewed each
23 side's opening brief filed in the pending cross-appeals from the rulings of the United
States Patent and Trademark Office's Patent Trial and Appeal Board ("PTAB") in
IPR 2016-00948 and IPR 2016-00949, the Court is satisfied that a stay of this matter is
necessary to avoid reaching a result in this case that is inconsistent with the ultimate
decision of the Federal Circuit. The PTAB deemed invalid 8 of the 20 claims of the
'525 Patent and 18 of the 20 claims of the '770 Patent, but rejected defendant's
arguments that other claims were likewise anticipated by or obvious over prior art. Both
parties challenge the PTAB's analysis, and the status of almost every claim in each patent
is at issue in the cross-appeals. Thus, conducting a trial as currently scheduled would be
an inefficient use of judicial resources. The trial date and all related dates and deadlines
are STRICKEN. The parties are DIRECTED to file a Joint Status Report within fourteen
(14) days after the United States Court of Appeals for the Federal Circuit issues a
decision in Ironburg Inventions Ltd. v. Valve Corporation, Case Nos. 18-1432, 18-1731,
& 18-1783, or by September 30, 2019, whichever occurs earlier.

20 (3) Defendant's motion to exclude certain expert testimony, docket no. 252,
21 and plaintiff's motions for partial summary judgment regarding inequitable conduct,
22 docket no. 258, for *inter partes* review estoppel, docket no. 260, and to bifurcate trial,
23 docket no. 294, are DEFERRED, and will be decided, if appropriate, after the stay of this
matter is lifted.

(4) The Clerk is directed to send a copy of this Minute Order to all counsel of record.

Dated this 15th day of November, 2018.

William M. McCool
Clerk

s/Karen Dews
Deputy Clerk